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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,582	09/08/2003	Robin G. Skinner	TEC1216-01	9887
832	7590	06/29/2005	EXAMINER	
BAKER & DANIELS LLP 111 E. WAYNE STREET SUITE 800 FORT WAYNE, IN 46802			TRIEU, THERESA	
			ART UNIT	PAPER NUMBER
			3748	

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/657,582	SKINNER, ROBIN G.
Examiner	Art Unit	
Theresa Trieu	3748	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 11 April 2005.  
 2a) This action is **FINAL**.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-10,13-15 and 17-19 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-10,13-15 and 17-19 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

## DETAILED ACTION

This Office Action is responsive to the applicants' amendment filed on April 11, 2005.

Claims 1, 4, 6, 8, 13 and 18 have been amended. Claim 11, 12, 16 has been canceled.

Overall, claims 1-10, 13-15 and 17-19 are pending in this application.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

**1. *Claims 1-3, 5-7, 9-11, 13-15, 17-19 are rejected under 35 U.S.C. 102(a) as being anticipated by Nojima et al. (Nojima) (Publication Number JP 2001-271752).***

Regarding claims 1, 6, 13, 17-19, as shown on Figs. 1 and 5, Nojima discloses a horizontal compressor assembly for compressing a gas and lubricated with oil, the compressor assembly comprising:

- a hermetic sealed housing (not numbered; however, clearly seen in Fig. 1) defining a high pressure discharge chamber (P) and low pressure chamber, the housing further defining an inlet opening (not numbered; however, clearly seen in Fig. 1-3) in fluid communication with the low pressure chamber, wherein the bottom portion of the low/high pressure chamber comprises a first/second oil reservoirs (5);

- a compressor mechanism (CF) disposed within the housing and defining a working space in which gas is compressed, the compressor mechanism having a first port (1) in communication with the discharge chamber; the compressor mechanism having a generally

horizontally oriented crankshaft, the compressor mechanism (CF) having an inlet in direct fluid communication with the low pressure chamber and the working space; a fixed scroll member (not numbered; however, clearly seen in Fig. 1) and an orbiting scroll member (not numbered; however, clearly seen in Fig. 1) are being mutual engaged wherein the fixed scroll member is sealed against the housing to define the discharge chamber;

- a second port (3a) in the discharge chamber (P) defining an outlet in the housing, the second port disposed vertically below the first port (1) in a lower half of the discharge chamber whereby oil collected (5) and wherein substantially all fluids entering the discharge chamber enter through the first port (1) and substantially all fluids exiting the discharge chamber exit through the second port (3a).

Regarding claims 2, 3, 5, 7, 9, 10, 14 and 15, Nojima further discloses a valve (2) sealingly engageable with the first port (1); a discharge tube (3) having an inlet positioned in the discharge chamber (P), the inlet defining the second port (3a); the first port (1) being located in the fixed scroll member; the discharge tube (3) extending through the housing; an inlet opening in communication with the low pressure chamber; low pressure chamber defining an oil sump (5); a motor for driving the compressor mechanism (CF).

#### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. *Claims 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nojima '752 in view of legal precedent.*

Nojima discloses the invention as recited above; however, Nojima fails to disclose a discharge tube being welded to the housing at the flat portion.

Regarding claims 4 and 8, a claim for an article capable of such definition must define the article by its structure and not by the process of making it. Since the claimed flat portion is capable of structural definition, the patentability of the claims must be determined solely on the basis of recited structure, exclusive of process recitations. *In re Johnson*, 394 f.2D 591, 157 USPQ 620, 55 CCPA 1463.

Applicants should also note that where a product by process claim is rejected over a prior art product that appears to be identical, although produced by a different process, the burden is upon the applicants to come forward with evidence establishing an obvious difference between the two. See *In re Marosi*, 218 USPQ 289 (Fed.Cir. 1983). Accordingly, the discharge tube extending through the housing and the housing including a flat portion do not result in any different structure than shown by the applied prior art.

*Response to Arguments*

Applicant's arguments with respect to claims 1-10, 13-15 and 17-19 have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

*Communication*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Theresa Trieu whose telephone number is 571-272-4868.. The examiner can normally be reached on Monday-Friday 8:30am- 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas E. Denion can be reached on 571-272-4859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TT  
June 22, 2005

  
Theresa Trieu  
Primary Examiner  
Art Unit 3748